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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/633,020
Filing Date: July 31, 2003
Appellant(s): SMITH ET AL.

Rupak Nag
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/06/2010 appealing from the Office action

mailed 07/08/2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying

by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings

known to the examiner which may be related to, directly affect or be directly affected by

or have a bearing on the Board's decision in the pending appeal:

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of

amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,014,748	**TUSHIE**	**1-2000**
2001/0042212	**DU**	**11-2001**
5,884,289	**ANDERSON**	**3-1999**

(9) Grounds of Rejection

Claim 1 – 3, 6, 11 – 13, and 16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Tushie et al. (Tushie hereinafter) (US Patent No. 6,014,748) in view

Du et al. (Du hereinafter) (US 2001/0042212).

Regarding Claim 1, Tushie discloses a method for automating the

personalization of a batch of smart cards that originates with a smart card issuer (Col. 5

and 6, lines 66 – 67 and 1 – 5, Tushie), comprising:

executing a personalization assistant tool (Col. 2, lines 38 – 40, Tushie), said

software tool including a default member profile having default values for smart card

features, a smart card feature being a parameter representing a business requirement

of said smart card issuer dictating smart card usage (Col. 2 and 18, lines 39 – 40 and 5

– 24, "The card framework template record describes the structure of the chip on the

card. In the sample shown below, the $MF entry defines a root directory (3F00), while

$DF entries define a medical application (5F20), and an accounting application (5F10).

Within each directory are application-specific files defined by $EF entries, such as 6F00

containing the account name and 6F10 containing the account number. All file

descriptive data resides in the card framework template and is referenced at various

times during the smart card issuing process", wherein the card framework template

record corresponds to the default member profile claimed; and wherein entries, such as,

account name and account number correspond to the default values for smart card

features; Col. 2, lines 54 – 59; Col. 8, lines 48 – 51; Col. 14, lines 3 – 5; Col. 17, lines 9

– 12; and Col. 14, lines 22 – 33, Fig. 11, items 1121, 1127, Fig. 13, items 1301, Col. 6,

lines 29 – 38, "cardholder's name, account number, card expiration date, and a

photograph. Because of its increased storage capacity, the chip in a smart card may

contain additional data beyond the basic information on the standard transaction card

including a graphical representation of the individual's signature, **data defining the**

types of service the cardholder is entitled to, and account limits for those

services…", wherein data defining types of service the cardholder is entitled to, and

account limits for those services are examples of smart card features…dictating smart

card usage as claimed; Col. 7, lines 45 – 52, "contains information about each individual

cardholder, such as name, account number, card expiration date, and **applicable**

services...", Col. 18, lines 5 – 31, "while $DF entries define a medical application … an

accounting application…", Tushie).

Furthermore, Tushie also discloses a method and system for receiving smart

card feature information (Page 6, lines 40 – 46, Tushie) that was previously entered into

a cardholder database management system by a user (Fig. 1B, item 152, Page 7, lines

48 – 59, Tushie). In addition, Tushie discloses that the smart card personalization

system will create smart cards according to the information received from alternate

inputs (Col. 6, lines 54 – 56, Tushie) and from a software tool (Fig. 1A, item 150, Card

Issuer Mgnt System, Page 9, lines 23 – 26 and 33 – 38; respectively, Tushie).

However, Tushie does not expressly disclose the details on how the user enters such

smart card information into the system. On the other hand, Du discloses computer

instructions for providing a user with a plurality of queries regarding said smart card

features said queries originating from said software tool ([0048], Du); receiving from the

user responses to the plurality of queries, said responses being received by said

software tool and reflecting smart card features desired by said smart card issuer

([0048], "queries the user through the User Interface 802 for the information needed

from the Smart Card 805 to configure the user's personal computing environment …,

depending on the user's preferences setting…", Du); matching each of said responses

with an output data value, said matching being performed by said software tool, each of

said output data values representing one of said smart card features and being suitable

for personalizing a smart card ([0049], and [0050], Du). It would have been obvious to

one of ordinary skill in the art at the time the invention was made to incorporate the

teachings of Du as a method for users to enter personalized information in the Tushie

system at Fig. 1B, item 152, Card Holder Data, to the smart card personalization system

of Tushie. Skilled artisan would have been motivated to do so, as suggested by Du

([0011], Du), to provide a smart card enabled mobile personal computing environment

system that creates an infrastructure for the management of a user's personal

computing environment data on a smart card.

The Tushie in view of Du combination (Tushie/Du hereinafter) also discloses:

modifying said default member profile to include said matched output data

values, said output data values replacing corresponding said default values for smart

card features ([0048], [0049], and [0050], Du); and

generating a personalization data file from said modified default member profiles

(Col. 16, lines 53 – 57, "…name of A file created by the card issuing management

system 950 that contains the cardholder data record(s)…"; and [0050], Du), wherein

said personalization data file is suitable for personalizing said batch of smart cards and

provides said smart card features on each smart card in said batch of smart cards for a

plurality of users wherein said batch of smart cards is personalized with respect to the

plurality of users by way of said output data values (Col.6 and 9, lines 42 – 47 and 33 –

38; respectively, "… The smart card personalization system 100 receives data from a

card issuer management system 150 (typically proprietary to the card issuer), translates

the data into a data stream, and outputs the data stream to personalization equipment

130 which personalizes the smart cards 160…"; Tushie; and [0050] and [0051], Du).

Regarding Claim 2, Tushie/Du discloses a method, further comprising:

using individual cardholder input files and the personalization data file to

personalize a said batch of smart cards to yield a plurality of personalized smart cards

(Col. 2, lines 46 – 54, Tushie; and [0050], Du).

Regarding Claim 3, Tushie/Du discloses a method, wherein said matching

includes:

providing a look up table with entries for various combinations of responses to

the plurality of queries (Col. 17, lines 13 – 25, Tushie; and [0055], records, Du);

finding a matching entry in the look up table that matches the responses to the

plurality of queries (Col. 17, lines 13 – 25, Tushie; and [0055], records, Du);

locating one of said output data values associated with the matching entry (Col.

17, lines 13 – 25, Tushie; and [0055], records, Du); and

outputting the one of said output data values associated to the matching entry

(Col. 17, lines 13 – 25, Tushie; and [0055], records, Du).

Regarding Claim 6, Tushie/Du discloses a method, further comprising providing

regional profiles and subregional profiles, wherein a subregion is within a region,

wherein the regional and subregional profiles have mandatory and recommended

settings, wherein some of the subregional profiles are more stringent than regional

profiles in which the subregions belong ([0046], and [0052], Du).

Claim 11 has been rejected under the same grounds as discussed in Claim 1.

Furthermore, Tushie/Du disclose: personalizing said batch of smart cards utilizing said

personalization data file, said personalization data file providing said smart card

features on each smart card in said batch of smart cards by was of said output data

values (Col. 2, lines 46 – 54, Tushie; and [0050], Du).

Regarding Claim 12, Tushie/Du discloses a computer implemented method,

further comprising:

sending the personalization data file to a preparation processing device (Fig. 1A,

item 100 and 150, Col. 6, lines 42 – 46, Tushie; and [0049], Du);

and

using the personalization data file and cardholder input files to personalize smart

cards (Fig. 1A, items 130 and 160, Col. 6, lines 45 – 47, Tushie; and [0049], Du).

Regarding Claim 13, Tushie/Du discloses a computer implemented method,

wherein said matching includes:

providing a look up table with entries for various combinations of responses to

the plurality of queries (Col. 17, lines 13 – 25, Tushie; and [0055], records, Du);

finding a matching entry in the look up table that matches the responses to the

plurality of queries (Col. 17, lines 13 – 25, Tushie; and [0055], records, Du);

locating one of said output data values associated with the matching entry (Col.

17, lines 13 – 25, Tushie; and [0055], records, Du); and

outputting the one of said output data values associated to the matching entry

(Col. 17, lines 13 – 25, Tushie; and [0055], records, Du).

Regarding Claim 16, Tushie/Du discloses a computer implemented method,

further comprising providing regional profiles and subregional profiles, wherein a

subregion is within a region, wherein the regional and subregional profiles have

mandatory and recommended settings, wherein some of the subregional profiles are

more stringent than regional profiles in which the subregions belong ([0046], and [0052],

Du).

Claims 4 – 5, and 14 – 15 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Tushie et al. (Tushie hereinafter) (US Patent No. 6,014,748), in view

Du et al. (Du hereinafter) (US 2001/0042212), and further in view of Anderson et al.

(Anderson hereinafter) (US 5,884,289).

Regarding Claim 4, Tushie/Du discloses all the limitations as discussed above

including one query regarding offline limits and thresholds (Col. 6, lines 32 – 38,

Tushie). However, Tushie/Du does not explicitly disclose that said smart card features

include account usage control, and account risk management. On the other hand,

Anderson discloses smart card features including: account usage control, and account

risk management ([57], Abstract, Col. 7, lines 55 – 60, "allowing the card issuer to limit

the on-going losses on that card"; Col. 8, lines 35 – 42; "i. All ATM/POS transactions

(approved or declined) for sample cards going back for a period of time (e.g., 3

months)", wherein for example "3 months" is part of the usage information as claimed;

Anderson). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to incorporate the Anderson's teachings to the system of

Tushie/Du. Skilled artisan would have been motivated to do so, as suggested by

Anderson ([57], Abstract, Anderson), to identify "at risk" cards in the criminal's

possession which have not yet been used, and to limit the losses to individual financial

institutions and the financial institution community at large.

Regarding Claim 5, the combination of Tushie in view of Du and further in view of

Anderson (Tushie/Du/Anderson hereinafter) discloses a method, wherein responses to

the plurality of queries are used to provide best practices recommendations (Col. 8,

lines 58 – 61, Tushie; and [0048], Du).

Regarding Claim 14, Tushie/Du/Anderson discloses a computer implemented

method, wherein the plurality of queries, comprise:

at least one query regarding smart card account usage control ([57], Abstract,

Anderson);

at least one query regarding smart card account risk management ([57], Abstract,

Anderson); and

at least one query regarding offline limits and thresholds (Col. 6, lines 32 – 38,

Tushie).

Regarding Claim 15, Tushie/Du/Anderson discloses a computer implemented

method, wherein responses to the plurality of queries are used to provide best practices

recommendations (Col. 8, lines 58 – 61, Tushie; and [0048], Du).

(10) Response to Argument

Claims 1-3, 6, 11-13 and 16 are rejected under 35 U.S.C. §103 as being

unpatentable over Tushie et al. (U.S. Pat. No. 6,014,748) in view of Du (U.S Pub. No.

2001/0042212).

Appellant argues that the applied art fails to disclose; "smart card features".

Examiner respectfully disagrees. The combination of Tushie in view of Du does

disclose: smart card features, a smart card feature being a parameter representing a

business requirement of said smart card issuer dictating smart card usage (Col. 2 and

18, lines 39 – 40 and 5 – 24, "The card framework template record describes the

structure of the chip on the card. In the sample shown below, the $MF entry defines a

root directory (3F00), while $DF entries define a medical application (5F20), and an

accounting application (5F10). Within each directory are application-specific files

defined by $EF entries, such as 6F00 containing the account name and 6F10

containing the account number. All file descriptive data resides in the card framework

template and is referenced at various times during the smart card issuing process",

wherein the card framework template record corresponds to the default member profile

claimed; and wherein entries, such as, account name and account number correspond

to the default values for smart card features; Col. 2, lines 54 – 59; Col. 8, lines 48 – 51;

Col. 14, lines 3 – 5; Col. 17, lines 9 – 12; and Col. 14, lines 22 – 33, Fig. 11, items

1121, 1127, Fig. 13, items 1301, Col. 6, lines 29 – 38, "cardholder's name, account

number, card expiration date, and a photograph. Because of its increased storage

capacity, the chip in a smart card may contain additional data beyond the basic

information on the standard transaction card including a graphical representation of the

individual's signature, **data defining the types of service the cardholder is entitled**

to, and account limits for those services...", wherein data defining types of service

the cardholder is entitled to, and account limits for those services are examples of

smart card features...dictating smart card usage as claimed; Col. 7, lines 45 – 52,

"contains information about each individual cardholder, such as name, account

number, card expiration date, **and applicable services...",** Col. 18, lines 5 – 31,

"while $DF entries define a medical application ... an accounting application..."

Tushie).

Appellant argues that the applied art fails to disclose; "querying a user and receiving responses".

Examiner respectfully disagrees. The combination of Tushie in view of Du does disclose: querying a user and receiving responses ([0048], "queries the user through the User Interface 802 for the information needed from the Smart Card 805 to configure the user's personal computing environment ..., depending on the user's preferences setting...", [0049], "[0050], Du).

Appellant argues that;" Du does not disclose smart card features".

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the combination of Tushie in view of Du disclose smart card features (Col. 2 and 18, lines 39 – 40 and 5 – 24, "The card framework template record describes the structure of the chip on the card. In the sample shown below, the $MF entry defines a root directory (3F00), while $DF entries define a medical application (5F20), and an accounting application (5F10). Within each directory are application-specific files defined by $EF entries, such as 6F00 containing the account name and 6F10 containing the account number. All file descriptive data resides in the card framework template and is referenced at various times during the smart card issuing

process", wherein the card framework template record corresponds to the default member profile claimed; and wherein entries, such as, account name and account number correspond to the default values for smart card features; Col. 2, lines 54 – 59; Col. 8, lines 48 – 51; Col. 14, lines 3 – 5; Col. 17, lines 9 – 12; and Col. 14, lines 22 – 33, Fig. 11, items 1121, 1127, Fig. 13, items 1301, Col. 6, lines 29 – 38, "cardholder's name, account number, card expiration date, and a photograph. Because of its increased storage capacity, the chip in a smart card may contain additional data beyond the basic information on the standard transaction card including a graphical representation of the individual's signature, **data defining the types of service the cardholder is entitled to, and account limits for those services**...", wherein data defining types of service the cardholder is entitled to, and account limits for those services are examples of smart card features...dictating smart card usage as claimed; Col. 7, lines 45 – 52, "contains information about each individual cardholder, such as name, account number, card expiration date, **and applicable services...",** Col. 18, lines 5 – 31, **"while $DF entries define a medical application ... an accounting application..."** Tushie).

In response to appellant's argument that; it is not "not obvious to combine because Du is non-analogous art", it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24

USPQ2d 1443 (Fed. Cir. 1992). In this case, the references: Du and Tushie are in the

field of appellant's endeavor of smart cards (see for example: [0048], Du; and Fig. 1A,

items: 150, 100, 130, and 160, Tushie).

Appellant argues that; "'personalization' data file is not disclose".

Examiner respectfully disagrees. The applied prior art does disclose a

personalization data file (Col. 16, lines 53 – 57, "...name of A file created by the card

issuing management system 950 that contains the cardholder data record(s)..."; and

[0050] – [0051], Du).

Appellant argues that; "cardholder data is not 'a parameter representing an

issuer business requirement dictating smart card usage' as required in claim 11".

Examiner respectfully disagrees. The combination of Tushie in view of Du does

disclose: a parameter representing an issuer business requirement dictating smart card

usage (Col. 2 and 18, lines 39 – 40 and 5 – 24, "The card framework template record

describes the structure of the chip on the card. In the sample shown below, the $MF

entry defines a root directory (3F00), while $DF entries define a medical application

(5F20), and an accounting application (5F10). Within each directory are application-

specific files defined by $EF entries, such as 6F00 containing the account name and

6F10 containing the account number. All file descriptive data resides in the card

framework template and is referenced at various times during the smart card issuing

process", wherein the card framework template record corresponds to the default

member profile claimed; and wherein entries, such as, account name and account

number correspond to the default values for smart card features; Col. 2, lines 54 – 59;

Col. 8, lines 48 – 51; Col. 14, lines 3 – 5; Col. 17, lines 9 – 12; and Col. 14, lines 22 –

33, Fig. 11, items 1121, 1127, Fig. 13, items 1301, Col. 6, lines 29 – 38, "cardholder's

name, account number, card expiration date, and a photograph. Because of its

increased storage capacity, the chip in a smart card may contain additional data beyond

the basic information on the standard transaction card including a graphical

representation of the individual's signature, **data defining the types of service the**

cardholder is entitled to, and account limits for those services...", wherein data

defining types of service the cardholder is entitled to, and account limits for those

services are examples of smart card features...dictating smart card usage as claimed;

Col. 7, lines 45 – 52, "contains information about each individual cardholder, such as

name, account number, card expiration date, **and applicable services...",** Col. 18, lines

5 – 31, **"while $DF entries define a medical application … an accounting**

application…" Tushie).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Giovanna Colan/

Examiner, Art Unit 2162

June 16, 2010

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